

REMARKS

Applicant respectfully requests consideration of the subject application. This Response is submitted in response to the Office Action mailed December 22, 2008. Claims 1, 8, 11-14, 16-19, 21, 22, 24-26, 31, 33, 35, 37, 45, 46, 48-51, 54-56, 58, 60, 72, 74 and 78-82 are pending. Claims 1, 8, 11-14, 16-19, 21, 22, 24-26, 31, 33, 35, 37, 45, 46, 48-51, 54-56, 58, 60, 72, 74 and 78-82 are rejected. No new matter has been added.

35 U.S.C. § 103 Rejections

The Examiner has rejected claims 1, 8, 11-14, 16-19, 21, 22, 24-26, 31, 33, 35, 37, 45, 46, 48-51, 54-56, 58, 60, 72, 74 and 78-82 under 35 U.S.C. § 103(a) as being unpatentable over Thomas, (U.S Patent No.: 6,128,663, hereinafter "Thomas") in view of Official Notice. Applicant submits that the claims are patentable.

In Thomas, column 4, lines 53-65 state as follows:

"A remote server receiving a page request (e.g., from such modified pages or modified page requests) is able to obtain the demographic identifier and use the demographics identifier to modify the content of the requested page to be transmitted over the network to the user such that it is more appropriate for the user. For example, the requested page often includes an advertising banner, and according to the invention, the particular advertising banner that is chosen to be transmitted with the requested page is determined, not randomly, but in accordance with the demographics identifier. Other modification could also be made such as providing a greeting, selecting an appropriate variant of the requested page or portion thereof, etc. "(Emphasis added)

What is clear from Thomas is that the following are served by a server to a client:

1. the requested page;
2. an advertising banner based on demographics; and
3. a customized greeting

What should be noted is that the greeting is not related to the advertisement. Just because the advertising banner is based on a demographic profile and the greeting is based on a demographic profile does not mean that the greeting relates to the advertisement. The demographic may for example be people earning \$20,000 to \$30,000. The advertising banner may be department stores for people earning \$20,000 to \$30,000. The text may be restaurants for people earning \$20,000 to \$30,000. The banner displayed and the text thus do not relate to one another.

Claim 1 specifically includes the limitation that “said message is thematically related to said advertisement.” Claim 1 thus includes at least one limitation that is not suggested by Thomas. Applicant respectfully submits that the Examiner is incorrect by stating that Thomas discloses “determining a message to be displayed on said World Wide Web page, wherein said message is thematically related to said advertisement (i.e. banner ad)(col. 4, lines 53-65 and col. 8, lines 64-66);...”

All the other claims rejected by the Examiner have limitations similar to the limitation in claim 1 that distinguishes over Thomas and should therefore be allowable for at least the same reasons as Claim 1. Applicant, accordingly, respectfully requests withdrawal of the rejections of claims 1, 8, 11-14, 16-19, 21, 22, 24-26, 31, 33, 35, 37, 45, 46, 48-51, 54-56, 58, 60, 72, 74 and 78-82 under 35 U.S.C. § 103 as being unpatentable over Thomas.

Official Notice

The Examiner has taken Official Notice of the following:

1. That it is old and well-known to receive personal information from a user such as a user's name, age and gender when a user fills out an application and the like;
2. That placing a message proximal to an ad or within the advertisement is old and well-known to bring the user's attention to the ad;
3. That it is old and well-known in marketing and the like to schedule a second message when a first message is no longer to be displayed. For example, during the Christmas season a certain message is displayed and when the season is over, a default or second message is displayed;
4. That changing display attribute within a message such as changing display color or image will bring the user's attention to the message; and
5. That it is old and well-known to serve default messages when targeting criteria hasn't been met. For example, default messages for or general messages are displayed to the customer when the customer hasn't established a relationship with a company in order for the company or advertiser to reach the general public.

Applicant respectfully requests that the Examiner not rely on Official Notice and that the Examiner instead provide prior art. Furthermore, Applicant respectfully requests that the Examiner provide convincing arguments for why such prior art would be integrated with Thomas by one skilled in the art. Furthermore, Applicant respectfully requests that the Examiner not use impermissible hindsight when making any such argument. Applicant notes that the present application was filed on June 3, 2002. Applicant respectfully requests that the Examiner provide convincing arguments why the prior art requested by Applicant would be combined with Thomas by someone of ordinary skill in the art at the time that the invention was made. Applicant therefore

respectfully requests that the Examiner refrain from making any such arguments based on the knowledge of someone of ordinary skill in the art at the time of making such an argument by the Examiner.

Final Office Action

Applicant requests withdrawal of the finality of the Office Action dated December 22, 2008.

Applicant respectfully submits that the present application is in condition for allowance.

Please charge any shortages and credit any overages to Deposit Account No. 19-3140. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 19-3140.

Respectfully submitted,
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